

REMARKS

Claims 5-27 are pending. In this paper, remarks are included to address the Restriction Requirement, new linking claim 27 has been added, and the specification has been amended to correct typographical errors.

Reconsideration of the application is respectfully requested for the following reasons.

In the Office Action, the Examiner alleged that the claims in Group I (claims 14-26) are drawn to a method of an image structure in which a feature of an image are expressed at different resolutions and the claims in Group II (claims 1-13) are drawn to a method of an image search for color similarity between a reference image and target image. Based on this characterization, the Examiner contends that the claims in both Groups are related as a distinct combination-subcombination and that a requirement for restriction is therefore proper. Applicant respectfully submits that the Restriction Requirement is improper, and thus should be withdrawn, for the following reasons.

First, the claims in Groups I and II are not related as combination-subcombination. MPEP § 806.05(a) provides: "A combination is an organization of which a subcombination or element is a part." In this test, it is implicit that the claims in both groups are drawn to the same statutory class of invention. For example, claims reciting an apparatus with elements (AB) would be considered a subcombination of claims reciting an apparatus with elements (ABC). Claims covering a method and claims covering a structure are not related as combination and subcombination, and this is true even though the method may use or otherwise perform an act on the structure.

The Group I claims cover an image data structure, not a method of an image data structure as alleged by the Examiner in the Office Action. The Group II claims are drawn to an image search method. Because the claims in Groups I and II are drawn to different statutory classes of invention, it is respectfully submitted that under the provisions of MPEP § 805.05(a) they cannot properly be characterized as combination-subcombination claims. Thus, Applicant submits that the Restriction Requirement is improper as a matter of form.

Second, MPEP § 803 clearly states: "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added).

It is respectfully submitted that a search and examination of all the presently pending claims in the application can be performed at once without serious burden to the Examiner. In this regard, it is emphasized that the search and examination of the claims in Group II (claims 1-13) which the Examiner has already performed necessarily included a search and examination of the image data structure recited in the claims of Group I (claims 14-26). This can be seen, for example, from amended claim 5. This claim recites the step of determining a color similarity between a reference image and a target image, each of which is represented by hierarchical grid levels. Because in at least one non-limiting embodiment of the invention, the different hierarchical grid levels may represent different resolutions, it is clear that conducting a search for the determining step of claim 5 would necessarily include a search for the subject matter of claim 14, which recites first and second grids for expressing a feature of an image at different resolutions.

Accordingly, the search for the claims in Group I which the Examiner already performed necessarily encompassed the subject matter of the claims in Group II. Furthermore, any additional search performed for the claims provisionally elected for further prosecution on the merits would still encompass this subject matter. Accordingly, examination of the claims in Group II may therefore be performed without serious burden to the Examiner and for at least this reason it is submitted that the restriction requirement is improper under the provisions of MPEP § 803.

Third, MPEP § 811 provides that when a restriction requirement is issued after at least one examination of the claims has taken place, the Examiner must consider whether "there will be a serious burden if restriction is not required." (Emphasis added). The serious burden referred to in this MPEP section is not a burden on the Examiner but rather the burden to Applicants. It is respectfully submitted that restriction at this stage in prosecution would impose serious burden on Applicant. The Examiner has already examined the claims of Group II which include a determining step that involves at least one form of a structure defined in the claims of Group I.. The burden of filing a divisional application with additional fees coupled with the additional delay in prosecution of the divisional application (with a commensurate reduction in patent term) would introduce substantial burden to Applicant. It is respectfully submitted that at least these hardships would make restriction improper under the provisions of MPEP § 811.

Based on at least the foregoing remarks, it is respectfully submitted that the Restriction Requirement is improper and should be withdrawn. Nevertheless, in the interest of providing a

complete response to the Requirement Applicant provisionally elects the claims of Group II (claims 5-13)¹ for further prosecution on the merits.

Notwithstanding the provisional election of these claims, it is noted that MPEP § 809 states: "Where, upon examination of an application containing claims to distinct inventions, linking claims are found . . . [t]he linking claims must be examined with the invention elected." (Emphasis added).

New claim 27 recites that the determining step of claim 5 is performed using a multilevel image data structure which is expressed based on an image grid having at least two different hierarchical levels. Claim 27 is therefore a linking claim linking the subject matter of claims 5 and 14. In view of the obligation imposed by MPEP § 809, Applicant respectfully submits that linking claim 27 should be examined with the claims of Group II which have been provisionally elected in this application.

The addition of claim 27 provides an additional basis upon which to conclude that a search and examination of the subject matter of the claims of elected Group II would necessarily encompass the subject matter of the claims of non-elected Group I, and that therefore because the claims in both Groups are co-extensive in scope all the presently pending claims in the application may be examined without presenting a burden to the Examiner.

With respect to the non-elected claims, Applicant reminds the Examiner that MPEP § 809.04 provides: "If a linking claim is allowed, the Examiner must thereafter examine . . . the claims to the non-elected invention that are linked to the elected invention by such allowed linking

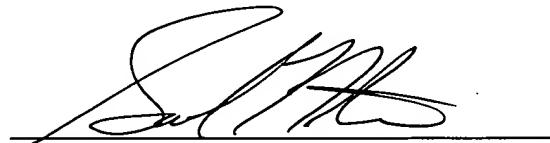
¹ In Applicant's previous Amendment, claims 1-4 were canceled. Thus, Group II includes claims 5-13 in addition to new claim 27 which is discussed in greater detail below.

claims." In view of the obligation imposed by MPEP § 809.04, Applicant respectfully requests the Examiner to postpone his decision to restrict the claims until he has decided upon the patentability of linking claim 27, since the Examiner will be required to examine the non-elected claims as part of the present application if he finds this linking claim to be allowable.

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance of the application is respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with this application, including extension of time fees, to Deposit Account No. 16-0607 (Attorney Docket No. P-082) and credit any excess fees to the same Deposit Account.

Respectfully submitted,



Carl R. Wesolowski
Registration No. 40,372

Samuel W. Ntiros
Registration No. 39,318

FLESHNER & KIM, LLP
P.O. Box 221200
Chantilly, Virginia 20153-1200
Telephone No: (703) 502-9440
Facsimile No: (703) 502-9596

Marked-Up Version of Amended Portions of Specification

The paragraph beginning at line 7 of page 2 was amended as follows:

However, in the above-described conventional image search method, the average importance for elements of a certain features is not useful, i.e., a pre-determination of an average value for elements of a certain features is not useful in image search since the importance of each element varies [caries] by a reference image or [of] target images [image].

The paragraph beginning at line 18 of page 2 was amended as follows:

Accordingly, it is an object of the present invention to provide a multilevel image data structure in which each level is expressed by the cells of a hierarchical structure of different levels by expressing one feature based on a multilevel image grid, and expressing a region representative color of each cell and a reliability with respect to the region representative color.

The paragraph beginning at line 22 of page 7 was amended as follows:

Two images I_1 and I_2 include first level image grids \underline{G}_{1_1st} [G_{1_1st}], G_{2_1st} , second level image grids G_{1_2nd} , G_{2_2nd} , and third level image grids G_{1_3rd} , G_{2_3rd} .